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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,362	03/04/2002	Naoto Yamada	Q67143	2731

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EXAMINER

TRAN, HUAN HUU

ART UNIT PAPER NUMBER

2861

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,362

Applicant(s)

YAMADA, NAOTO

Examiner

Huan H. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 and dependent claims thereof are indefinite for failure to positively recite in the claim sufficient structural limitations to support the functional wherein statements with respect to the function of the conveyance rollers. The conveyance rollers themselves cannot perform the recited function without the control of a controller. Per MPEP 2173.05(g0, a functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. In this instance, the recited elements specifically recited in the claims, namely the two pairs of conveyance rollers and the leading edge detector, cannot perform the recited function by themselves.

It should be noted that language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. MPEP 2106, p 2100-8.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 3, 5 are rejected under 35 U.S.C. 102(a or e) as being clearly anticipated by Kato et al.

As to claim 1, Kato et al. discloses an image recording apparatus for exposing a photosensitive material to record an image on the photosensitive material, comprising a nipping and conveyance arrangement for aiding in conveying the photosensitive material along a conveyance path in the image recording apparatus, the nipping and conveyance arrangement comprising:

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two pairs of conveyance rollers mountable in the image recording apparatus, with one pair (36) disposed upstream from an exposure position relative to conveyance direction of the photosensitive material along the conveyance path during exposure, and one other pair (38) disposed downstream from the exposure position, in which the pairs of conveyance rollers nip and convey the photosensitive material during exposure, and;

a detector (col. 10, lines 17-20) detecting a leading edge of the photosensitive material, wherein at least the upstream pair of conveyance rollers nipping at least a leading edge of the photosensitive material when the photosensitive material passes through the upstream pair of conveyance rollers and the pairs of conveyance rollers releasing the photosensitive material, at least momentarily, after the leading edge has passed through the downstream pair of conveyance rollers based on an output of the detector.

Regarding the manner in which the conveyance rollers are operated as recited in claims 1, 3 and 5, it should be noted that apparatus claims must be structurally distinguishable from the prior art. Apparatus claims cover what device is, not what device does, and thus invention need not operate differently than prior art in order to be patentable, but need only be different. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). MPEP 2114.

Allowable Subject Matter

4. Claims 11-21 are allowed.

5. The following is a statement of reasons for the indication of allowable subject matter: Prior art of record do not teach or suggest a control arrangement for controlling the nip roller pairs in the manner recited in the claims.

Response to Arguments

6. Applicant's arguments filed on 11/03/03 have been fully considered but they are not persuasive. Per MPEP 2173.05(g), functional language does not, in and of itself, render a claim improper. In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. In this instance, the functional limitation fail to comply

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with 35 U.S.C. 112, second paragraph for the reason stated in the rejection above.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huan H. Tran whose telephone number is (703) 308-0749. The examiner can normally be reached on M-F with Monday off, from 7:30am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stepphen Meier can be reached on (703) 308-4896. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1749.



Huan H. Tran
Primary Examiner
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01/15/2004